

REJECTION UNDER 35 U.S.C. § 103(A)

Claims 61, 62, 64, 66-68, 73, 74, 76-79, 81, 84, 89, 90, 92, 93, 95, 97, 98, 103, 104, 106, 108, 110, 111, 116 and 118

The Office Action rejected claims 61, 62, 64, 66-68, 73, 74, 76-79, 81, 84, 89, 90, 92, 93, 95, 97, 98, 103, 104, 106, 108, 110, 111, 116 and 118 under 103(a) as being unpatentable over Itkis (U.S. Patent no. 4,856,787) in view of Saikawa (U.S. Patent no. 6,509,896) and Martin (U.S. Patent no. 5,618,232). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

Itkis apparently discloses a distributed game network with a master game device and a number of slave game devices. The slave game device apparently is capable of playing concurrently a number of games such as poker, bingo, blackjack and keno. The slave game device apparently receives commands from the master game device and sends the local game status and accounting information to the master game device. The slave device apparently has a touch screen and also discloses that a light pen may be used to select images. When images are selected, Itkis apparently discloses that the image selected is displayed as crosshatched.

Saikawa apparently discloses an image processing unit for an action shooting game in which suitable images can be displayed according to a given situation, and in which more exciting and easy-to-manipulate images are displayed. Coordinate values for images in three-dimensional virtual space are established on the basis of prerecorded image shape data. Apparently, a gun can be used to play the games and the gun may have air-powered recoil. An object of the Saikawa invention apparently is to provide an image processing unit displaying images that are more playable and more exciting.

Martin apparently discloses an electronic game device system that is switchable between an amusement mode and a gaming or gambling mode where the switch may be automatic depending on the geographical location of the system. Martin also apparently

discloses an improved method of operating a touch screen on a CRT or LCD computer screen which uses finger release as input registering, and also may use highlighting of a button area when pointed to by a user for any highlighted button.

The claimed device in each of independent claims 61, 77, 92 and 106 discloses a gaming machine that includes a user input device comprising a virtual object, said virtual object being shaped like an object, to point on a display device where an image on the display device is highlighted in response to the user pointing the virtual object at a portion of the image and where the virtual object provides feedback to the user when a selectable image on the display is selected.

THE PROPOSED COMBINATION OF ITKIS, SAIKAWA AND MARTIN

The Office Action proposes a combination of the Itkis, Saikawa and Martin references as a basis to reject all the pending claims. Other references are added to the Itkis, Saikawa and Martin combination to address additional limitations present in the dependent claims. The applicant argues that the Itkis, Saikawa and Martin combination is improper in that there is no motivation to combine the references as indicated by the different problems that each reference is addressing.

Itkis addresses the problem of playing traditional casino games where players can play against each other by using slave machines that are in communication with a master game machine. There is no mention of playing games beyond the traditional casino games.

Saikawa is concerned with developing an improved manner to manipulate, track and shoot at images in a virtual three-dimensional space in an action game. Saikawa also is concerned with adding further realism to action games such as baseball or shooting games by adding feedback to the pointing device. Saikawa is also interested in making the game more challenging by using an improved method of tracking and displaying images to make it more challenging to shoot at the moving or obscured images.

Martin is concerned with creating a game that can be switched between a gambling game and an amusement game in order to not break any laws (possibly depending on the location of the game) and providing an improved touch screen.

Of the three references, Itkis and Martin are concerned with traditional casino based games. Saikawa is concerned with tracing and selecting moving images such as a baseball or a monster and selecting (or shooting at) such moving images necessitates a different type of pointer. As the references are addressing different problems, there is no motivation to combine them as required by MPEP, Section 2145.X.C.

In Saikawa, using a traditional touch screen (or light pen) to track and select moving images would not be nearly as effective or fun. In addition, the goal of tracing a moving image is more challenging and stimulating when using a known object such as a gun or a remote control. The additional requirement of "good aim" adds another element to the game because in such games, an individual not only has to select the proper image on the display, the user has to properly aim at the image which often times is moving or purposely obscured.

Further, in a casino based game such as Itkis or Martin, the casinos want a player to make a selection. The images that can be selected are stationary and often are located in prominent locations to make selection easier. As the images to be selected are intentionally stationary and clearly visible, it make sense to use a traditional touch screen as there is little or no challenge involved in making a selection in a traditional casino game. In addition, the casinos want players to make a selection so it would be illogical in Itkis or Martin to look to add to Saikawa the element of attempting to select/shoot a moving image.

Accordingly, there is no suggestion as required by MPEP 2145.X.C to combine a traditional casino game like Itkis or Martin with a pointing device from an action game like Saikawa. In a traditional casino game, the images that can be selected are stationary. In an action game like Saikawa, the images that can be selected move, making tracking and

selection a challenge which in turn makes having a virtual object as a selection device make sense. As MPEP section 2145.X.C states "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings." There is no motivation or suggestion to add the pointing device of Saikawa to Itkis or Martin because the casino that uses Itkis or Martin type games do not desire to make selection a challenge so there is no motivation to add a Saikawa like selection device to Itkis or Martin. Because Itkis/Martin and Saikawa are addressing different problems, there is no motivation in the references or in the knowledge generally available to combine the references. *See In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999) (reciting the need for findings regarding the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or other factual findings to support an obviousness analysis).

A second reason that the pending application is not obvious in view of Itkis, Saikawa and Martin is that all the independent claims as amended call for the virtual object to provide feedback to the user. Providing feedback is found in Saikawa which makes sense as it is an action game. However, Itkis and Martin are traditional casino games and it does not make sense to add feedback to a non-action game as described in Itkis or Martin. In a traditional casino game, there is little challenge to selecting an image as the images are stationary and prominent so it would not make sense to add feedback to successfully selecting a stationary image. Certainly, there is no teaching or motivation in Itkis or Martin to make this combination. Providing feedback is a significant leap forward from the teaching of Itkis or Martin. The input device itself is an afterthought to the teachings of Itkis and Martin and providing feedback would be beyond their teachings or suggestions.

The mere fact that Itkis could be modified is not sufficient to establish a prima facie case of obviousness. See Section 2143.01 of the M.P.E.P. All that is important in Itkis and

Martin is that a user can input information and Itkis and Martin discloses inputting information using either a touch screen or a light pen. There is no motivation to add the feedback pointing device of Saikawa to Itkis or Martin because the casinos do not desire to make selection of an image a challenge and there is no support to make such a combination.

Claims 75, 91, 105 & 117

The Office Action rejected claims 75, 91, 105 & 117 under 35 USC 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 73, 89, 103 and 116 and further in view of Yamazaki, U.S. patent 6,251,011 ("Yamazaki"). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

Claims 63, 80 and 107

The Office Action rejected claims 63, 80 and 107 under 35 USC 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 61, 77 and 106 and further in view of Halic (U.S. Patent no. 5,700,195) and Hara et al. (U.S. Patent no. 5,027,415). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

Claims 65, 82, 96 and 109

The Office Action rejected claims 65, 82, 96 and 109 under 35 U.S.C 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 61, 77, 92 and 106 in view of Pendergrass, Jr. (U.S. Patent no. 5,565,148). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

Claims 69, 85, 99 and 112

The Office Action rejected claims 69, 85, 99 and 112 under 35 USC 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 61, 77, 92 and 106 in view of DeMar et al. (U.S. Patent no. 6,270,410). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

Claims 69, 85, 88, 99 and 112

The Office Action rejected claims 69, 85, 88, 99 and 112 under 35 USC 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 61, 77, 92 and 106 in view of Ahdoot. (U.S. Patent no. 5,913,727). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

Claims 70, 72, 86, 88, 100, 113 and 115

The Office Action rejected claims 70, 72, 86, 88, 100, 113 and 115 under 35 USC 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 61, 77, 92 and 106 in view of Ahdoot (U.S. Patent no. 5,913, 727). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

Claims 71, 97, 101 and 114

The Office Action rejected claims 71, 97, 101 and 114 under 35 USC 103(a) as being unpatentable over Itkis, Saikawa and Martin as applied to claims 61, 77, 92 and 106 in view of Yamazaki et al. (U.S. Patent no. 5,800, 265). The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of the combination of Itkis, Saikawa and Martin because there is no motivation to combine these references.

In view of the foregoing, it is respectfully submitted that all claims in the present application are in condition for allowance.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

Respectfully submitted,

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